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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/506,261	02/17/00	PALATOV	D MGANO-010A

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EXAMINER

TRAN, H

ART UNIT

PAPER NUMBER

2611

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/506,261

Applicant(s)

PALATOV ET AL.

Examiner

Hai Tran

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 30-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 02 March 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6,7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Drawings*

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on March 12, 2001 have been accepted.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 30-32, 34, and 37-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (US 5909638) in view of Tatebayashi et al. (US 6182215 B1).

Regarding claim 30, Allen discloses a system for distributing video content (Fig. 1, Abstract), the system comprising:

An interactive kiosk configured to be located in a public location (fig. 16) (Col. 22, lines 15-40), the kiosk further configured to receive and access the video content storage *device* (VHS videotape, recordable laser disk or DVD, see Col.1, lines 25-32).

Allen does not clearly disclose the kiosk further configures to securely store video content on the portable video content storage device upon which digitally encoded video content is securely stored to prevent unauthorized access, and a set-

top box configured to receive the portable video content storage device, to access the securely stored video content from the portable video content storage device and to provide the video content as an output signal to a video display.

Tatebayashi describes a method to securely store video content on the portable video content storage device upon which digitally encoded video content is securely stored to prevent unauthorized access (Col. 1, lines 55-Col. 2, lines 38) and further discloses a set-top box (Fig., 2; elements 101) configured to receive the portable video content storage device (Fig., 2; elements 104, 105, 106, 102, 103), to access the securely stored video content from the portable video content storage device and to provide the video content as an output signal to a video display (Fig. 1, 2; elements 108). Furthermore, Fig. 5 shows element 101 as a broadcast satellite receiver which reads on the claimed "set top box" (see col. 10, lines 15-47).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Allen's system to securely configure the kiosk to securely store video content on the portable video content storage and to prevent unauthorized access to stored video content on the portable video content storage device, as taught by Tatebayashi, so to prevent the video productions/recording from being distributed to unauthorized devices (Col. 1, lines 47-50).

Regarding claim 32, Tatebayashi further discloses wherein the portable video content storage device consists essentially of passive storage media unit (Col.8, lines 5-15).

Regarding claim 34, the method claim 34 is analyzed with respect to apparatus claim 30.

Regarding claim 37, the hand-held dedicated secure video content storage device is analyzed with respect to claim 30. The communication port mounted in the housing of Tatebayashi's devices (Fig. 1, 2; elements 104, 105, 106, 102, 103) is obvious to be removable configured to connect/disconnect to the Kiosk.

Regarding claim 38, Tatebayashi's devices (Fig. 1, 2; elements 104, 105, 106, 102, 103) further discloses wherein the communication port comprises an electrical connector (fig., element 107).

Regarding claim 39, Tatebayashi fails to show the communication port comprise an optical connector.

Official Notice is taken that the use of an optical connector is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tatebayashi by including an optical connector so to provide a more choice of connectivity between devices.

Regarding claim 40, see analysis of claim 30.

Regarding claim 41, see analysis of claim 30.

Regarding claim 42, Tatebayashi's devices (Fig. 1, 2; elements 104, 105, 106, 102, 103) all have a disk drive.

Regarding claim 43, with the teaching of Tatebayashi ' authentication protocols (Col. 8, lines 15-65+), Tatebayashi clearly encompass the claimed limitation "configured to separately limit read and write access to the disk drive".

2. Claims 31, 35-36, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (US 5909638) in view of Tatebayashi et al. (US 6182215 B1), and further in view of Russo (US 5619247).

Regarding claim 31, Allen and Tatebayashi do not clearly disclose wherein the set-top box is configured to write content use data to the portable video content storage device.

Russo discloses wherein the set-top box is configured to write content use data to the storage device (Col. 10, lines 10-39). Therefore, it would have been obvious to an ordinary skill in the art at the time the invention was made to modify Allen in combination with Tatebayashi to write content use data to a portable storage instead of a storage device, as suggested by Russo, so to keep track the usage of users for the billing purposes (Col. 3, lines 15-30).

Regarding claim 35, method claim 35 is analyzed with the same respect to apparatus claim 31.

Regarding claim 36, with the teaching of Tatebayashi and Russo, Allen's kiosk system will be able to read content use data stored from the portable video content storage device so to complete billing service from the central distribution site (Col.1, lines 60-65+).

Regarding claim 45, see analysis of claim 31.

3. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (US 5909638) in view of Tatebayashi et al. (US 6182215 B1), and further in view of Peterson, Jr (US 5825876).

Regarding claim 33, Allen and Tatebayashi do not clearly disclose wherein the encode video content stored on the storage medium is encrypted to prevent unauthorized access.

Peterson discloses encoded video content stored on the storage medium is encrypted to prevent unauthorized access (Col. 3, lines 27-29 and col. 5, lines 50-58; Fig.1, elements 28 and 30). Therefore, it would have been obvious to an ordinary skill in the art at the time the invention was made to modify Allen in combination with Tatebayashi to encode encrypted video content stored on the storage medium so to provide more security to access of the content as suggested by Peterson (Col. 4, lines 30-33).

4. Claims 44 and 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (US 5909638) in view of Tatebayashi et al. (US 6182215 B1), and further in view of Abecassis (US 5696869).

Regarding claim 44, Allen and Tatebayashi do not disclose wherein the controller comprises a data buffer configured to buffer data as the data is transferred to or from the disk drive.

Abecassis discloses wherein the controller comprises a data buffer configured to buffer data as the data is transferred to or from the disk drive (Col.10, lines 33-

60). Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to modify Allen and Tatebayashi to have a data buffer configured to buffer data as the data is transferred to or from the disk drive, as taught by Abecassis, so to retrieve subsequent from information from the video disk without altering the transmission of the required frames per second to provide a transparently continuous video signal transmission , as suggested by Abecassis (Col.10, lines 35-40).

Regarding claims 46 and 47, Allen and Tatebayashi do not disclose wherein the controller is configured to limit access to the mass storage module based at least upon a content rating of a content unit and a set of user preference relating to the format content units to be stored on the mass storage module.

Abecassis discloses the controller is configured to limit access to the mass storage module based at least upon a content rating of a content unit (Col. 10, lines 50-col. 11, lines 15) and a set of user preference relating to the format content units to be stored on the mass storage module (Col. 11, lines 15-23).

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to modify Allen and Tatebayashi to limit access to the mass storage module based at least upon a content rating of a content unit so to provide a video program that is highly responsive to viewer control over its content (see col. 5, lines 5-12).

5. Claims 48-51, 53, 57-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks (US 5559549) in view of Russo (US 5619247).

Regarding claim 48, Hendricks discloses a set-top box for accessing video content stored on a portable video content storage device, the set-top box comprising:

A receptacle configured to receive the portable video content storage device, wherein the portable video content storage device can be inserted and removed by a user (Fig. 5a, element 635; Col. 15, lines 8-14);

A video decoder module configured to decode the video content to produce an output signal; and a processor configured to control the video decoder module (Fig. 4 and fig. 6); Col.14, lines 21-60)

Hendricks does not clearly disclose a processor configured to accumulate present content use data based at least upon an amount use of the video content and to store the accumulated content use data onto the portable video content on the portable video content storage device.

Russo discloses wherein the set-top box is configured to accumulate present content use data and to write content use data to the storage device (Col. 10, lines 10-39). Therefore, it would have been obvious to an ordinary skill in the art at the time the invention was made to modify Hendricks to accumulate and write content use data to a portable storage instead of a storage device, as suggested by Russo, so to keep track the usage of users for the billing purposes (Col. 3, lines 15-30).

Regarding claim 49, Hendricks further discloses wherein the processor is further configured to control the portable video content storage device (Col. 15, lines 35-50).

Regarding claim 50, Hendricks further discloses a decryption module (Fig. 4, element "Decrypt".);

Regarding claim 51, Hendricks further discloses a translation module configured to translate a non-standard communication protocol used by the portable video content storage device (SCSI) into an industry standard communications protocol (Col. 15, lines 40-65+).

Regarding claim 53, Hendricks further discloses wherein the output signal comprises video information and audio information (see Fig. 4).

Regarding claims 57 -59, the method claims 57 – 59 are analyzed with respect to claim 48.

Regarding claim 60, Russo further discloses the content use data comprises a listing of executed user commands (Col. 9, lines 38- col. 10, lines 10)

Regarding claim 61, russo further discloses the content use data associates a number of uses with a portion of the video content (Col. 10, lines 10-22).

6. Claims 52 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks (US 5559549) in view of Russo (US 5619247), and further in view of Tatebayashi et al. (US 6182215 B1).

Regarding claim 52, Hendricks and Russo does not clearly disclose the STB further comprising an authentication module configured to provide authentication information to the portable video content storage device.

Tatebayashi discloses an STB's authentication module configured to provide authentication information to the portable video content storage device (Fig. 5; elements 101 and Fig., 2; elements 104, 105, 106, 102, 103). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hendricks's system to securely configure the authentication of the portable video content storage, as taught by Tatebayashi, so to prevent the video productions/recording from being distributed to unauthorized devices (Col. 1, lines 47-50).

Regarding claim 62, method claim 62 is analyzed with respect claim 48 in combination with claim 52.

7. Claims 54 -56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks (US 5559549) in view of Russo (US 5619247), and further in view of Abecassis (US 5696869).

Regarding claims 54-56, Hendricks and Russo do not disclose wherein the processor is further configured to access user preferences stored on the portable video content storage device based at least upon a content rating of the content unit and to modify the user references.

Abecassis discloses the processor of a Video disk player is further configured to access user preferences stored on the portable video content storage device based at least upon a content rating of the content unit and to modify the user references, (Col. 9, lines 53-Col. 10, lines 32; Col. 10, lines 50- col. 11, lines 15; Col. 11, lines 15-23).

Art Unit: 2611

Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to modify Hendricks and Russo to configured to access user preferences stored on the portable video content storage device based at least upon a content rating of the content unit and to modify the user references, so to provide a video program that is highly responsive to viewer control over its content (see col. 5, lines 5-12).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Davis (US 5825879) shows a system and method for copy-protecting distributed video content.

Sako et al. (US 5802174) shows a data recording medium.

Uesaka et al. (US 6044157) shows a microprocessor suitable for reproducing AV data while protecting the AV data from illegal copy and image information processing system using the microprocessor.

Schulhof et al. (US 5557541) shows an apparatus for distributing subscription and on-demand audio programming.

Art Unit: 2611

**Contact Fax Information**

**Any response to this action should be mailed to:**

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**or Faxed to:**

(703) 872-9314 (for formal communication intended for entry)

**or:** (for informal or draft communications, please label "PROPOSED" or "DRAFT")


Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA. Sixth Floor (Receptionist).

**Contact Information**

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is (703) 308-7372. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-5399.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.



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